

REMARKS

Telephonic Interview of January 3, 2005

Applicant expresses appreciation for Examiner Becker's courtesy and professionalism in conducting a telephonic interview on January 3, 2005. During that telephonic interview the substance of the present Amendment was discussed. Examiner Becker agreed that the present Amendment would obviate the rejection imposed in the December 14, 2004 Office Action under the second paragraph of 35 U.S.C. § 112. Applicant also noted that if the rejection under the second paragraph 35 U.S.C. § 112 is overcome and the claim limitation requiring a rotary paddle stationary vessel massager or rotary vessel tumbler containing impact vanes is accorded the weight to which it is legally entitled, then the rejections predicated upon Bellue would fall, because such limitations were ignored in imposing the rejections predicated upon Bellue. It was also pointed out that the present Amendment does not generate any new matter issue since the limitation with respect to a rotary paddle stationary vessel massager or a rotary vessel tumbler containing impact vanes not only should have been given consideration but apparently was given consideration by the Examiner in imposing the rejections predicated upon Horn et al.

It is Applicant's understanding from the telephonic interview that the present Amendment would be entertained and given consideration. Certainly, the present Amendment should be entered because it manifestly reduces the number of issues, notably the rejection under the second paragraph under 35 U.S.C. § 112 and the rejection predicated upon Bellue, thereby placing this Application in better condition for Appeal. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are solicited pursuant to the provisions of 37 C.F.R. § 1.116.

The Claims

Claims 11 and 17 through 41 are pending in this Application, of which claims 11, 17, 21, 29 and 33 are in independent form. Independent claims 11, 17, 21, 29 and 33 have been amended to address a perceived formalistic issue by basically moving the claim limitation with respect to a rotating paddle stationary vessel massager or rotating vessel tumbler containing impact vanes from what the Examiner considered the preamble of each claim to the body of each claim. Therefore, the present Amendment clarifies that such element, i.e., a rotating paddle stationary vessel massager or rotating vessel tumbler containing impact vanes, is part of the claimed apparatus and such a massager or tumbler contains a vessel which receives bodies of meat for agitating the bodies of meat to distribute the treating liquid in the bodies of meat during agitation. The present Amendment does not generate any new matter issue and the present Amendment does not generate any new issue for that matter, not only because the limitation was previously in the claims, but because the Examiner has already apparently treated such a limitation as part of the claims by imposing rejections based upon Horn et al. Moreover, as previously pointed out, the present Amendment clearly reduces the number of issues on Appeal. Accordingly, Applicant again solicits entry and favorable consideration of the present Amendment pursuant to 37 CFR § 1.116.

Claims 11 and 17 through 41 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner asserted it is not clear whether the structure recited in the preamble is part of the claimed device or not. This rejection is traversed.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a **question of law**, not an exercise in grammar. *Personalized Media Communications LLC v. U.S. International Trade Commission*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998); *Tillotson, Ltd v. Wlaboro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the Examiner must provide a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope of protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedents holds that **reasonable precision** in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Zoltek Corp. v. United States*, 48 Fed. Cl. 240, 57 USPQ2d 1257 (Fed. Cl. 2000); *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc., v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPA2d 1333 (Fed. Cir. 1993); *U.S. v. Teletronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ (Fed. Cir. 1986). Applicant stresses that claims must be interpreted through the eyes of one having ordinary skill in the art in light of and consistent with the context of the written description of the supporting specification. *Metabolite Laboratories Inc. v. Laboratory Corp. of America Holdings*, __F.3d__, 71 USPQ2d, 1801 (Fed. Cir. 2004); *Zoltek Corp. v. United States*, *supra*; *Miles Laboratories, Inc. v. Shandon, Inc. supra*.

In applying the above legal tenets to the exigencies of the case, Applicants submit that a *prima facie* basis to deny patentability to the claimed invention under the second paragraph of 35

U.S.C. § 112 has not been established. Specifically, there is **no litmus test** triggering the ultimate legal conclusion of indefiniteness under the second paragraph of 35 U.S.C. § 112 because a claim limitation appears in the preamble. Moreover, simply because some claim language may be viewed as less than absolutely precise does not automatically result in indefiniteness under the second paragraph of 35 U.S.C. § 112. *Seattle Box Co., Inc. v. Indus Crating & Parking, Inc.*, 731 F.2d 818, 826 [221 USPQ 568] (Fed. Cir. 1984).

Applicant submits that even without the present Amendment one having ordinary skill in the art would have understood that the claimed apparatus comprises a paddle stationary **vessel** massager or rotating **vessel** tumbler containing impact vanes and it is that vessel of the rotating paddle stationary **vessel** massager or rotating **vessel** tumbler containing impact vanes that appears in the body of the claim and receives bodies of meat in contact with the treating liquid, because it is in that vessel that the bodies of meat are agitated to distribute the treating liquid therein. The agitation, of course, stems from the fact that the **vessel** is part of a paddle stationary **vessel** massager or rotating **vessel** tumbler containing impact vanes. This is how one having ordinary skill in the art would have interpreted the claimed inventions, because these are the two basic types of meat treating devices as apparent from the Examiner's reference to Gould, noting column 1 of Gould, third full paragraph.

At any rate, in order to expedite prosecution and with no intent to otherwise limit the scope of the claimed inventions, each of independent claims 11, 17, 21, 29 and 33 has been amended by indicating, in the body of the claim, the presence of either a rotating paddle stationary vessel massager or rotating vessel tumbler containing impact vanes, as part of the claimed apparatus. Each of the rotating paddle stationary **vessel** massager or rotating **vessel** tumbler containing impact vanes comprises a **vessel**, and it is that vessel which receives bodies

of meat in contact with the treating liquid in which agitation occurs to distribute the treating liquid in the bodies of meat. Clearly, one having ordinary skill in the art would have no difficulty understanding the scope of the claimed inventions, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Metabolite Laboratories Inc. v. Laboratory Corp. of America Holdings, supra*; *Miles Laboratories, Inc. v. Shandon, Inc., supra*.

Applicant, therefore, submits that the imposed rejection of claims 11 and 17 through 41 under the second paragraph of 35 U.S.C. §112 is not legally viable, and, hence solicits withdrawal thereof.

Claims 21, 29 and 33 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Bellue.

In the statement of rejection the Examiner again referred to Fig. 1 of Bellue and to column 3, lines 32 through 43, asserting the disclosure of an apparatus corresponding to that claimed. This rejection is traversed.

In the responsive Amendment submitted November 18, 2004, it was stressed that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). It was further stressed that there are significant differences between the claimed

apparatus and Bellue's apparatus that scotch the factual determination that Bellue discloses an apparatus identically corresponding to that claimed.

It was initially noted that each of the rejected claims is directed to an apparatus **structured to distribute a treating liquid in a body of meat by agitation**. In other words, the apparatus claimed must be capable of distributing the treating liquid in bodies of meat by agitation. There is no apparent factual basis upon which to predicate the determination that the "cooking pot" disclosed by Bellue is **capable** of distributing a treating liquid in bodies of meat by agitation, as in the claimed invention. *See, Intel Corp. v. U.S. International Trade Commission, 946 F.2d 821, 20 USPQ2d 116 (Fed. Cir. 1991).*

Indeed, as one having ordinary skill in the art would have recognized, and as disclosed by Gould in the third full paragraph at column 1, apparatuses employed for treating a body of meat in contact with a treating liquid are typically a tumbler, which contains paddles or baffles imparting impact energy on the muscle tissue of meat, or a massager which kneads bodies of meat. Such types of apparatus do not include a "cooking pot" as disclosed by Bellue.

It was also argued that the independent claims were amended by requiring the apparatus to comprise either a rotating paddle stationary vessel massager or rotating vessel tumbler containing impact vanes. It was stressed that Bellue's "cooking pot" is not a rotating paddle stationary vessel massager or a rotating vessel tumbler containing impact vanes. It was also stressed that Bellue's "cooking pot" is not structured to distribute a treating liquid in bodies of meat by agitation.

In the fifth enumerated paragraph commencing at page 2 of the December 14, 2004 Office Action, the Examiner, in the penultimate sentence, asserts that:

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structure limitations are able to stand alone.

Initially, generalizations may be of academic interest but not relevant to the present situation, because the present claims do not recite intended uses, or the purpose of a process. Rather, each of the independent claims previously recited “An apparatus ... which comprises a rotating paddle stationary vessel massager or rotating vessel tumbler containing impact vanes ... thereby affirmatively requiring the presence of a rotating paddle stationary **vessel** massager or a rotating **vessel** tumbler containing impact vanes. The next paragraph of the claim defined the vessel which is structured to distribute the treating liquid in bodies of meat by agitation. Thus, it is the preamble which provides antecedent basis for claim terms, i.e., the vessel, and must be given consideration, it being legally erroneous to ignore such a required claim element. *Electro Scientific Industries v. Dynamic Details, Inc.*, 307 F.3d 1343, 64 USPQ2d 1781, (Fed. Cir. 2002); *Bell Communications Research, Inc. v. Vidal Link Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

At any rate, as discussed during the January 3, 2005 telephonic interview, all of the independent claims, including claims 21, 29 and 33, have been amended without any intent to otherwise limit the scope of the claimed invention by affirmably reciting that the claimed apparatus comprises, in the body of the claim, a rotating paddle stationary **vessel** massager or rotating **vessel** tumbler containing impact vanes, and that each such massager or tumbler comprises a **vessel** for receiving bodies of meat in contact with the treating liquid and for agitating said bodies of meat to distribute the treating liquid in the bodies of meat. No such structure is disclosed or suggested by Bellue.

The above argued structural differences between the claimed apparatuses and Bellue's "cooking pot" undermine the factual determination that Bellue discloses an apparatus ("cooking pot") identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra; Kloster Speedsteel AB v. Crucible Inc., supra.* Applicant, therefore, submits that the imposed rejection of claims 21, 29 and 33 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bellue is not factually viable and, hence, solicits withdrawal thereof.

Claims 22 and 23 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Burkhart.

This rejection is traversed.

Claims 22 and 23 depend from independent claim 21. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 21 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bellue. Specifically, Bellue neither discloses nor suggests a rotating paddle stationary vessel massager or a rotating vessel tumbler containing impact vanes, as recited in claim 21. Moreover, there is no apparent factual basis upon which to predicate the determination that Bellue's cooking pot is capable of distributing a treating liquid in bodies of meat as claimed. The additional reference to Burkhart does not cure the argued deficiencies of Bellue.

Indeed, the Examiner relies upon Burkhart for a temperature sensor. Even if Bellue is modified as suggested by the Examiner in view of the teachings of Burkhart, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result, because the resulting apparatus would still be a "cooking pot"- **not** a rotating

paddle stationary vessel massager or a rotating vessel tumbler containing impact vanes, capable of distributing a treating liquid in bodies of meat. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Accordingly, a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, it is apparent that the Examiner improperly declined to consider the potent indicia of **nonobviousness** previously argued during prosecution.

Specifically, Applicant **discovered problems** attendant upon conventional practices of massaging bodies of liquid-injected meat at a relatively low temperature. These problems are disclosed in paragraphs [0008] and [0009] of the written description and include, for example, impedance of effective massaging by virtue of water binding to proteins released from the meat to form a compound which may be exuded and form a coating or internal barrier, thereby impeding penetration, absorption and/or dispersion of the treatment solution. Other problems include the inability to develop uniform internal coloration, reduction of friction and breakdown of treating solutions, such as polyphosphates and nitrites by enzymes in the meat, thereby preventing effective and efficient utilization of such additives. Applicants **discovery of such problems** attendant upon conventional practices of massaging bodies of liquid-injected meat at a low temperature have **not** been disputed on this record and must, therefore, be accepted. *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976). It is well settled that the **discovery** of a **problem** attendant upon prior art practices constitutes a potent indicium of **nonobviousness** which must be given consideration. *In re Spinnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1969).

There is another potent indicium of **nonobviousness** stemming from the problem addressed and solved by the claimed invention which must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). These problems addressed and solved by the claimed invention, as previously pointed out, relate to the impedance of effective massaging and effective utilization of treating solutions (paragraphs [0008] and [0009] of the written description). None of the applied references discloses or expresses any recognition of such problems, because they are addressed to **cooking pots**. Under such circumstances, the problems addressed and solved by the claimed invention must be given consideration as a potent indicium of **nonobviousness**.

Conclusion

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to potent indicium of **nonobviousness** stemming from Applicant's discovery of problems attendant upon prior art practices and the solutions thereto encompassed by the claims, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. § 103. *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

Applicant, therefore, submits that the imposed rejection of claims 22 and 23 under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Burkhart is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 24 and 25 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Burkhart and DE 3119496A.

This rejection is traversed. Specifically, claims 24 and 25 depend from claim 22 which, in turn, depends from independent claim 21. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 21 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bellue, and the imposed rejection of claim 22 under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Burkhart. The additional reference to DE 3119496A does not cure the argued deficiencies of Bellue, or the argued deficiencies in the attempted combination of Bellue and Burkhart. Accordingly, even if the applied references are combined as suggested by the Examiner, and again Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*

Applicant, therefore, submits that the imposed rejection of claims 24 and 25 under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Burkhart and DE 3119496A is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 26, 30 and 34 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Ludwig.

In the statement of the rejection the Examiner admitted that Bellue does not disclose a refrigeration unit and a rotary paddle. The Examiner then points to Ludwig's meat massager and concludes that one having ordinary skill in the art would have been motivated to modify Bellue's "cooking pot" to incorporate a refrigeration unit and then to incorporate torque controlled paddles, erroneously asserting that both of the applied references are directed to meat massaging devices **which they are not**. This rejection is traversed as factually and legally erroneous.

Bellue discloses a **cooking pot for cooking food**. Ludwig discloses a **paddle massager** for treating meat products with an aqueous solution, such as a brine, by massaging meat products in the presence of the brine. The Examiner did not discharge the judicially imposed initial burden by making the requisite **clear and particular** factual findings as to a **specific** understanding or **specific** technological principle and then, based upon such factual determinations explain **why** one having ordinary skill in the art would have been realistically led to modify Bellue's **cooking pot** by providing internal rotary paddles for massaging the meat during cooking. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). That Bellue's **cooking pot** is rotatable does not convert it into a **paddle meat massager**. That the Examiner calls Bellue's **cooking pot** a meat massaging device does not make it so. The paddles of Ludwig are designed for massaging. Bellue does not seek to massage.

The Examiner asserts the torque control disclosed by Ludwig improves water bonding without damage to the muscle tissue. What that determination has to do with the obviousness issue at hand is not apparent. But Applicant would stress that the Examiner conspicuously eschews identifying anything in Bellue which would suggest that “improved water bonding without damage to the muscle tissue” is desired for cooking in the disclosed **cooking pot**.

Based upon the foregoing it should be apparent that the Examiner did not establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, as previously argued, there are potent indicia of **nonobviousness** of record stemming from Applicant’s discovery of problems attendant upon prior conventional processes for distributing a treating liquid in bodies of meat which constitutes **evidence of nonobviousness**. *In re Spinnoble, supra*. Moreover, the failure of the applied prior art to address or suggest a solution to such problems constitutes further evidence of **nonobviousness** which must be given consideration. *North American Vaccine, Inc. v. American Cyanamid Co., supra*; *Northern Telecom, Inc. v. Datapoint Corp., supra*; *In re Newell, supra*; *In re Nomiya, supra*.

Indeed, the primary reference to Bellue is a **cooking pot**, not an apparatus as claimed, which is structured to distribute a treating liquid throughout bodies of meat. Accordingly, the problems addressed and solved by the claimed invention are of no interest to Bellue.

Based upon the foregoing, it should be apparent that the Examiner did not establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the potent indicia of **nonobviousness** of record, stemming from Applicant’s discovery of the source of problems attendant upon conventional practices and the solutions

encompassed by the claims, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. § 103. *Jones v. Hardy, supra*.

Applicant, therefore, submits that the imposed rejection of claims 26, 30 and 34 under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Ludwig is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 17 through 19, 27, 28, 31, 32, 35 and 36 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Ludwig and Burkhart.

This rejection is traversed.

Again, Bellue is directed to a **cooking pot**. Ludwig is directed to a device structured to control the torque of rotary paddles in treating bodies of meat with a treating fluid, such as brine, for distribution therein. Bellue does not seek to distribute any fluids throughout bodies of meat. There is no conceivable reason why one having ordinary skill in the art would have been realistically impelled to modify Bellue's **cooking pot** by providing the **rotary paddle torque control system** of Ludwig. The additional reference to Burkhart does not cure the argued deficiencies in the attempted combination of Bellue and Ludwig.

As previously argued, the Examiner did not make the requisite clear and particular factual findings as to a specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify Bellue's **cooking pot** by providing torque control means for rotary paddles therein, particularly since Bellue's cooking pot is not a meat massaging device but just what the title says – a "cooking pot". *In re Lee, supra*;

Ecolochem Inc. v. Southern California Edison, Co., supra; In re Kotzab, supra; In re Dembiczak, supra; In re Rouffet, supra.

Moreover, as also previously argued, the Examiner declined to give any consideration to a potent indicia of **nonobviousness** stemming from Applicant's discovery of the source of problems attendant upon prior art practices, or the problems addressed and solved by the claimed invention which do not exist in Bellue's **cooking pot**, and Bellue is the primary reference. *In re Spinnoble, supra; North American Vaccine, Inc. v. American Cyanamid Co., supra; Northern Telecom, Inc. v. Datapoint Corp., supra; In re Newell, supra; In re Nomiya, supra.*

Based upon the foregoing Applicant submits that the Examiner did not establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the potent indicia of nonobviousness of record stemming from Applicant's discovery of the source of problems attendant upon prior art practices and Applicant's solution thereto encompassed by the claims, the conclusion appears inescapable that one having ordinary skill in the art would not have found the claimed invention as a whole obvious within the meaning of 35 U.S.C. § 103. *Jones v. Hardy, supra.*

Applicant, therefore, submits that the imposed rejection of claims 17 through 19, 27, 28, 31, 32, 35 and 36 under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Ludwig and Burkhardt is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 11 and 20 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Ludwig, Burkhardt and DE 3119496A.

This rejection is traversed. As previously argued, the Examiner did not make the requisite clear and particular factual findings as to a specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify Bellue's specific **cooking pot** by providing rotary paddles and torque control means as disclosed by Ludwig in connection with a massaging device, because Bellue's device is not a meat massager but a **cooking pot** as the title states and as disclosed. *In re Lee, supra*; *Ecolochem Inc. v. Southern California Edison, Co., supra*; *In re Kotzab, supra*; *In re Dembiczak, supra*; *In re Rouffet, supra*. The additional references to Burkhardt and DE 3119496A do not cure the argued deficiencies in the attempted combination of Bellue and Ludwig.

Moreover, as also previously argued, the Examiner improperly declined to consider the potent indicia of nonobviousness of record stemming from Applicant's discovery of the source of problems attendant upon prior art meat massaging practices and the solutions thereto encompassed by the claims. *In re Spinnoble, supra*; *North American Vaccine, Inc. v. American Cyanamid Co., supra*; *Northern Telecom, Inc. v. Datapoint Corp., supra*; *In re Newell, supra*; *In re Nomiya, supra*.

Applicant, therefore, submits that a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the potent indicia of **nonobviousness** of record stemming from Applicant's discovery of the source of problems attendant upon prior art meat massaging practices (and Bellue is not concerned with meat massaging but **cooking**) and Applicant's solution thereto encompassed by the claims, the

conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. § 103. *Jones v. Hardy, supra.*

Applicant, therefore, submits that the imposed rejection of claims 11 and 20 under 35 U.S.C. § 103 for obviousness predicated upon Bellue in view of Ludwig, Burkhardt and DE 3119496A is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 21, 26, 29, 30, 33, 34 and 39 through 41 were rejected under 35 U.S.C. § 103 for obviousness predicated by Horn et al. in view of Gould.

In the statement of the rejection the Examiner accurately **admitted** that Horn et al. do **not** disclose a marinating apparatus having heating means. The obvious fact should be stated. The **reason** Horn et al. do **not disclose** an apparatus containing **heating** means is because Horn et al. **do not want to heat anything**. Rather, as discussed in greater detail *infra*, Horn et al. are concerned **only** with **chilling** because **heat is problematic** to Horn et al. Nevertheless, the Examiner concluded that one having ordinary skill in the art would have been motivated to proceed **against** the teachings of Horn et al. by modifying the disclosed apparatus to include heating means simply because heating means are perceived to reside in the reference to Gould. This rejection is traversed.

As previously pointed out, to establish the requisite realistic motivation the Examiner is required to make clear and particular factual findings as to a specific understanding or specific technological principle and, based upon such factual findings, explain why one having ordinary skill in the art would have been realistically impelled to modify a particular prior art, in this case the “**refrigerated** cylindrical drum paddle agitator mixer” disclosed by Horn et al. (column 1,

lines 9 through 11) to arrive at the claimed invention. *In re Lee, supra; Ecolochem Inc. v. Southern California Edison, Co., supra; In re Kotzab, supra; In re Dembiczak, supra; In re Rouffet, supra.* That burden has not been discharged.

Specifically, as previously indicated, the apparatus disclosed by Horn et al. is intended to effect **rapid vacuum chilling**. In the context of Horn et al., it is helpful to review column 2, lines 39 through 51, wherein it is disclosed that vacuum chilling and tumbling works well for certain meats, such as ham. However, it is not effective for other meat products, notably poultry. This is because there is insufficient heat exchange area per volume to effectively chill the poultry during a short massaging cycle of only 20 to 25 minutes. There is not enough time for efficient heat transfer to occur to reduce the temperature during this short vacuum massage cycle. It should be noted that in column 2 of Horn et al., lines 13 and 14, it is made clear that the problem addressed and solved by Horn, as well as others in the industry, is the **problem of heat generation**. In short, heat is a bad actor; fast chilling is desired.

Consistent with the above goal of **avoiding heating and effecting rapid chilling**, Horn et al. provide a structure with a hollow paddle agitator to **reduce heat and maximize heat exchange** thereby resulting in a product that "... is chilled at an extremely rapid rate" (column 3 of Horn et al., lines 20 and 21).

As Horn et al. want **rapid chilling** and want to **avoid heating**, Applicant submits it is inconceivable that one having ordinary skill in the art would somehow have been realistically impelled to impress heating means on the apparatus disclosed by Horn et al. *In re Lee supra, In re Rouffet, supra.* Moreover, it is well settled that one having ordinary skill in the art cannot be realistically motivated to modify a reference in a manner of which is antithetic to the disclosed objective, i.e., provide heating means in order to achieve rapid chilling. In fact, any such

modification of the device disclosed by Horn et al. would render it **inoperative** for its intended purposes. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).

Further, it is clear that Horn et al. **teach away** from the claimed invention by avoiding heat and effective rapid chilling. This **clear teaching away** from the claimed invention by the primary reference to Horn et al. constitutes a potent indicium of nonobviousness. *Ecolochem Inc. v. Southern California Edison, Co.*, *supra*; *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

Moreover, as previously argued, there are additional indicia of nonobviousness which must be given consideration. Applicant discovered problems attendant upon conventional practices of massaging bodies of liquid-injected meat at a relatively low temperature. Applicant's discovery of such problems constitutes a potent indicium of nonobviousness which must be given consideration, particularly since the primary reference to Horn et al. teaches away from the claimed invention. *In re Sponnoble*, *supra*.

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the potent indicia of **nonobviousness** stemming from the **clear teaching away** from the claimed invention by the primary reference to Horn et al. and Applicant's **discovery of problems**

dependent upon prior art practices, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed subject matter **as a whole** obvious within the meaning of 35 U.S.C. § 103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Applicant, therefore, submits that the imposed rejection of claims 21, 26, 29, 30, 33, 34 and 39 through 41 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al., in view of Gould is not factually or legally viable, and hence, solicits withdrawal thereof.

Claims 17, 27 and 38 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould and Ludwig.

This rejection is traversed. As previously argued, one having ordinary skill in art **would not** have been realistically motivated to modify the rapid chilling massaging device disclosed by Horn et al. by providing heating means in view of Gould, because such a modification of the device disclosed by Horn et al. would render it **inoperative** for its intended purpose of effecting rapid chilling. Moreover, Horn et al. **clearly teach away** from the claimed invention by preventing heating, thereby underscoring the nonobviousness of the claimed subject matter as a whole. *Ecolchem Inc. v. Southern California Edison, Co., supra*. The additional reference to Ludwig does not cure the argued deficiencies in the attempted combination of Horn et al. and Gould.

Applicant, therefore, submits that one having ordinary skill in the art would not have found the claimed subject matter as a whole obviousness under 35 U.S.C. § 103 predicated upon Horn et al. in view of Gould and Ludwig. Applicant, therefore, submits that the imposed rejection of claims 17, 27 and 38 under 35 U.S.C. § 103 for obviousness predicated upon Horn et

al. in view of Gould and Ludwig is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 11, 22 through 25, 31, 35 and 37 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould and DE 3119496A.

This rejection is traversed.

As previously argued, one having ordinary skill in the art would **not** have been realistically motivated to modify the rapid chilling device disclosed by Horn et al. by providing heating means in view of Gould, because such a modification of the device disclosed by Horn et al. would render it **inoperative** for its intended purpose. *In re Finch, supra, In re Gordon, supra; In re Schulpen, supra.* Moreover, Horn et al. **clearly teach away** from heating by preventing heating and implementing rapid chilling, thereby underscoring the nonobviousness of the claimed subject matter as a whole. *Ecolochem Inc. v. Southern California Edison, Co., supra.* The additional reference to DE 3119496A does not cure the argued deficiencies in the attempted combination of Horn et al. and Gould.

Moreover, one having ordinary skill in the art would not have been realistically motivated to provide a temperature sensor in the system of Horn et al. which is designed to effect rapid chilling in a very short period of time. Simply put, there is no need to sense any temperature because there is no heating, only rapid chilling.

Applicant, therefore, submits that the imposed rejection of claims 11, 22 through 25, 31, 35 and 37 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould and DE 3119396A is not factually or legally viable, and, hence, solicits withdrawal thereof.

Claims 18 through 20 and 28 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould, Ludwig and DE 3119496A

This rejection is traversed.

Claims 18 through 20 depend from independent claim 17 while claim 28 depends from independent claim 21. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 21 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould and the imposed rejection of claim 17 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould and Ludwig. The additional reference to DE 3119496A does not cure the argued deficiencies in the attempted combination of Horn et al. in view of Gould and Ludwig.

Moreover, Applicant would stress that one having ordinary skill in the art would not have been motivated to provide a temperature sensor in the apparatus disclosed by Horn et al. because the apparatus disclosed by Horn et al. is designed to effect rapid chilling. *In re Lee, supra*.

Applicant, therefore, submits that the imposed rejection of claims 18 through 20 and 28 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould, Ludwig and DE 3119496A is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 32 and 36 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of DE 3119496A, Gould and Ludwig.

This rejection is traversed. Specifically, claim 32 depends from claim 29 and claim 36 depends from claim 33. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 29 and 33 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of Gould. The additional references to DE 3119496A and

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Ludwig do not cure the argued deficiencies in the attempted combination of Horn et al. and Gould. Applicant, therefore, submits that the imposed rejection of claims 32 and 36 under 35 U.S.C. § 103 for obviousness predicated upon Horn et al. in view of DE 3119496A, Gould and Ludwig is not factually or legally viable and, hence, solicits withdrawal thereof.

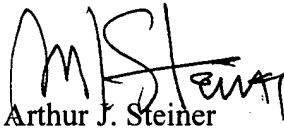
Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'MJS' followed by a stylized 'Steiner'.

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